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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,091	11/20/2003	Herman Rodriguez	AUS920030869US1	9426

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IBM CORP (AP)
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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/718,091

Applicant(s)

RODRIGUEZ ET AL.

Examiner

April Y. Shan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/2003 and 04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 have been examined.

Information Disclosure Statement

2. The information disclosure statement filed 20 November 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 15 April 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. For items AE, AG and AH, the Applicant missed author's name. For item AF, the Applicant listed page 46-49, however, the Applicant submits 6 pages document. For item AJ, the publisher name listed is contradicted with the actually NPL the Applicant submits. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-10 and 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-10 are directed to a method for security screening of electronic devices. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed steps do not result in a tangible result. Claims 1-10 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claims 21-28 are directed a computer program product stored on a computer operable medium for security screening of electronic devices. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. First, the claimed computer program product stored on a computer operable medium do not result in a tangible result. Claims 1-10 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77). Second, in accordance with Applicant's specification page 12, paragraph [0030], lines 9-10, is "acoustic, electromagnetic, or light waves...". . This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process,

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machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 29-30 are directed a method for facilitating secure screening of electronic devices. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed steps do not result in a tangible result. Claims 29-30 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-8, 10-18, 20-27 and 29-30 are rejected under 35 USC 103(a) as being unpatentable over McClelland et al. (U.S. Patent No. 7,139,406) in view of Lee et al. (U.S. Patent No. 6,650,240)

As per **claims 1 and 11**, McClelland et al. discloses a method/system for security screening of an item, comprising:

detecting an identifier from an item (e.g. col. 9, lines 6-11, col. 20, lines 35-42 and step 536 in fig. 14);

querying a database with said identifier for information about said item (e.g. step 538 in fig. 14 and col. 20, lines 43-55); and

responsive to receiving said information about said item from said database, (e.g. col. 10, line 53- col. 11, line 10, col. 16, line 61 – col. 17, line 3 and col. 20, lines 58-67).

McClelland et al. does not disclose expressly an item is an electronic device, information includes information about the item and comparing at least one real-time scanned characteristic of said item with said information, wherein if said at least one real-time scanned characteristic and said information match, then the item is considered secure.

Lee et al. discloses an item of baggage is an electronic device, such as a laptop computer, a mobile telephone, camera and so forth the col. 1, lines 13-20.

McClelland et al. discloses that the system and methods in the reference can also be used to "an inspection machine may be used to obtain an X-ray image of a component, and the component may include a unique identifier used to link the component to the X-ray image. A remote operator may examine the image, or an algorithm may be implemented to examine the image, to detect whether the component has any defects", in col. 21, lines 20-37. Any electronic device is made of components. When a remote operator/algorithm examines the image, it would have been obvious to one with ordinary skill in the art to compare the scanned component with the

specification/previous image/information of a non-defective component storing in a database. If match found, then the component is good. In the case of an airport, the above step helps to decide whether this component of an electronic device is indeed a component of an electronic device and therefore to decide whether it is secure or not.

McClelland et al. and Lee et al. are analogous art because they are from the same field of endeavor of carrying items during travel.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate an electronic device of Lee et al.'s as an item of baggage of McClelland et al.'s during the trip and comparing at least one real-time scanned characteristic of said item with said information, wherein if said at least one real-time scanned characteristic and said information match, then the item is considered secure.

The motivation for doing so would have been "desirable to screen passenger baggage for potential threats or contraband items. In light of recent terrorist activities, it is becoming more important to accurately screen baggage", as taught by McClelland et al., col. 1, lines 19-22 and "in recent years a large number of type of portable devices have been developed to meet consumer demands. These are devices that are designed and intended to be carried, including when traveling on holiday and on business trips", as taught by Lee et al., col. 1, lines 13-16.

As per **claims 2 and 12**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al.

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further discloses transmitting a radio frequency signal within a particular area for detecting said electronic device (e.g. col. 18, lines 30-32); and reading said identifier from said electronic device broadcast from an antenna attached to a memory of said electronic device (e.g. col. 18, lines 37-48).

As per **claims 3 and 13**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al. further discloses querying said database with said identifier for information comprising physical characteristics of said electronic device (e.g. col. 10, line 66 – col. 11, line 10).

As per **claims 4 and 14**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al. further discloses querying said database with said embedded identifier for information comprising an x-ray overlay of said electronic device (e.g. col. 6, lines 63-65 and fig. 4b).

As per **claims 5 and 15**, the combined teachings of McClelland et al. and Lee et al. discloses a method/system as applied above in claims 1 and 11. McClelland et al. further discloses scanning a three-dimensional image of said electronic device to attain a density signature for a plurality of components of said electronic device (e.g. col. 1, lines 34-49 and col. 4, lines 30-32); and comparing said density signature of said three-

dimensional image with a previously recorded density signature returned with said information for said electronic device (e.g. col. 21, lines 20-37).

As per **claims 6 and 16**, the combined teachings of McClelland et al. and Lee et al. discloses a method/system as applied above in claims 1 and 11. McClelland et al. further discloses tracing a schematic figure of a plurality of components of said item from a real-time x-ray scan (e.g. fig. 4B) and comparing said schematic figure of said plurality of components with a previously recorded schematic figure returned with said information for said electronic device (e.g. col. 21, lines 20-37)

As per **claims 7 and 17**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al. further discloses comparing a real-time x-ray scan of said electronic device with a previously recorded x-ray scan returned with said information for said electronic device (e.g. col. 21, lines 20-37).

As per **claims 8 and 18**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al. further discloses detecting a second identifier for a component of said electronic device (e.g. col. 21, lines 20-32); and querying said database with said second identifier for second information about said component (e.g. col. 21, lines 20-37); responsive to receiving said second information about said component from said database layered

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with said information for said electronic device, comparing at least one real-time scanned characteristic of said electronic device and said component with said layered information (e.g. col. 21, lines 20-37); and responsive to receiving said second information about said component from said database separate from said information for said electronic device, comparing at least one real-time scanned characteristic of said component with said second information for said component (e.g. col. 21, lines 20-37).

As per **claims 10 and 20**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11. McClelland et al. further discloses querying said database with said identifier via a network (e.g. col. 5, line 66 – col. 6, line 2 and col. 8, lines 37-41).

As per **claims 21-27**, the combined teachings of McClelland et al. and Lee et al. disclose the claimed method of steps as applied above in claims 1-7. Therefore, the combined teachings of McClelland et al. and Lee et al. disclose the claimed computer program product stored on a computer operable medium for carrying out the method of steps.

As per **claim 29**, McClelland et al. discloses a method for facilitating secure screening of items of baggage comprising:

receiving a request for information about an item
identified by a unique identifier (e.g. col. 10, lines 38-51);

searching a database for said unique identifier (e.g. col. 10, lines 38-53); and responsive to locating information for said unique identifier in said database, (e.g. col. 10, lines 38-56)

McClelland et al. does not disclose expressly an item of baggage is an electronic device and returning said information formatted according to said request, such that an security screening system requesting said information is enabled to determine whether said item is secure by matching said information to a real-time scanned characteristics of said item.

Lee et al. discloses an item of baggage is an electronic device, such as a laptop computer, a mobile telephone, camera and so forth the col. 1, lines 13-20.

McClelland et al. discloses that the system and methods in the reference can also be used to "an inspection machine may be used to obtain an X-ray image of a component, and the component may include a unique identifier used to link the component to the X-ray image. A remote operator may examine the image, or an algorithm may be implemented to examine the image, to detect whether the component has any defects", in col. 21, lines 20-37. Any electronic device is made of components. When a remote operator/algorithm examines the image, it would have been obvious to one with ordinary skill in the art to compare the scanned component with the specification/previous image of a non-defective component. If match found, then the component is good. In the case of an airport, the above step helps to decide whether this component of an electronic device is secure or not.

McClelland et al. and Lee et al. are analogous art because they are from the same field of endeavor of carrying items during travel.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate an electronic device of Lee et al.'s as an item of baggage of McClelland et al.'s during the trip and comparing at least one real-time scanned characteristic of said item with said information, wherein if said at least one real-time scanned characteristic and said information match, then the item is considered secure.

The motivation for doing so would have been "desirable to screen passenger baggage for potential threats or contraband items. In light of recent terrorist activities, it is becoming more important to accurately screen baggage", as taught by McClelland et al., col. 1, lines 19-22 and "in recent years a large number of type of portable devices have been developed to meet consumer demands. These are devices that are designed and intended to be carried, including when traveling on holiday and on business trips", as taught by Lee et al., col. 1, lines 13-16.

As per **claim 30**, the combined teachings of McClelland et al. and Lee et al. disclose a method as applied above in claim 29. McClelland et al. further discloses receiving a request for information about an added component of said electronic device by a unique component identifier, wherein said added component is in addition to an original configuration of said electronic device (e.g. col. 21, lines 20-37. Please note "components" is disclosed in col. 21, line 28 and "a component" is disclosed in col. 21,

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line 30.); searching said database for said unique component identifier (e.g. col. 21, lines 20-37); and layering said information for said unique component identifier with said information for said electronic device, such that said information returned to said security screening device is a composite representing a current configuration of said electronic device (e.g. col. 21, lines 20-37).

9. Claims 9, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClelland et al. and Lee et al. as applied to claims 1 and 11 above, and further in view of Examiner's official notice.

As per **claims 9 and 19**, the combined teachings of McClelland et al. and Lee et al. disclose a method/system as applied above in claims 1 and 11.

The combined teachings of McClelland et al. and Lee et al. do not further disclose determining whether said electronic device is properly positioned for scanning and responsive to detecting that said electronic device is not properly positioned for scanning, triggering an alert signal that an electronic device is not properly scannable. The Examiner takes Official Notice that one of ordinary skill in the art would know determining whether said electronic device is properly positioned for scanning and responsive to detecting that said electronic device is not properly positioned for scanning, triggering an alert signal that an electronic device is not properly scannable (A scanning machine in the airport/office building/hospital will beep if the items/patients placed on the Conveyor belt do not positioning correct. Usually the security guards/medical staff will reposition the items/patients after learning

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the beep). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature motivating by "desirable to screen passenger baggage for potential threats or contraband items. In light of recent terrorist activities, it is becoming more important to accurately screen baggage", as taught by McClelland et al., col. 1, lines 19-22.

As per **claim 28**, the combined teachings of McClelland et al. and Lee et al and Examiner's official notice. disclose the claimed method of steps as applied above in claims 9. Therefore, the combined teachings of McClelland et al. and Lee et al. and Examiner's official notice disclose the claimed computer program product stored on a computer operable medium for carrying out the method of steps.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)

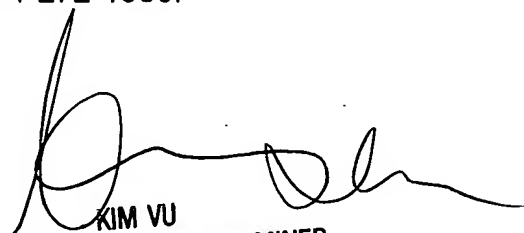
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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30 January 2007
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